

## **REMARKS**

### **Introduction**

Applicant notes with appreciation the Examiner's indication that each of the references cited in the Information Disclosure Statement of April 21, 2006 have been considered.

Upon entry of the foregoing amendment, claims 1-7 are pending in the application. Claims 1 and 4 have been amended. No claims have been added or cancelled. In view of the following remarks, reconsideration and allowance of all the pending claims are respectfully requested.

### **Objection to the Specification**

The Examiner has objected to the specification for failing to comply with the requirements of 37 CFR 1.77(b). In particular, the Examiner suggested that Applicant amend the specification to list the various sections of the application. In accordance with the Examiner's suggestions, Applicant submits herewith a substitute specification including the changes suggested by the Examiner. This substitute specification does not contain any new matter. Therefore, Applicant respectfully requests that the Examiner withdraw the objection.

### **Objection to the Claims**

Claims 6 and 7 were objected to as containing minor informalities. Applicant has amended these claims to correct the informalities pointed out by the Examiner.

### **Claim Rejection Under 35 USC 102**

Claims 1-6 have been rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 2,747,944 to Baermann. Applicant respectfully requests reconsideration of this rejection for at least the following reasons.

Applicant has amended independent claim 1 to recite "at least one annular permanent magnet (2, 3) divided in a circumferential direction thereof at at least one location (4) into a plurality of segments, said segments spaced apart from one another at said at least one location; and an annular binding band (5) surrounding said at least one

annular permanent magnet.” It is respectfully submitted that Baermann does not teach these features.

Figure 1 of Baermann, which is cited by the Examiner, shows two axially magnetized annular magnets 3 mounted upon a shaft 2 and situated opposite annular magnets 4, which are attached to a casing 4a so that an annular spacing is formed between each pair of magnets 3, 4. *See* column 4, lines 30-36 of Baermann. It is evident from Figure 1 of Baermann, that Baermann’s annular magnets 3 and 4 are divided and spaced apart along the radial direction, i.e., in a direction moving outwardly away from the shaft 2. Therefore, these magnets 3 and 4 are not “divided in a circumferential direction thereof,” as presently recited in independent claim 1. In other words, because Baermann’s annular magnets 3 and 4 are continuous around their respective circumferences, these magnets 3 and 4 are not “divided in a circumferential direction thereof,” as presently recited in independent claim 1 of Applicant’s invention. Moreover, the magnets 3 and 4 shown in Baermann do not include “a plurality of segments...spaced apart from one another,” as recited in claim 1, because these magnets 3 and 4 are continuous rings. Therefore, Applicant submits that Baermann fails to teach each of the features of independent claim 1 of Applicant’s invention.

Baermann’s magnetic bearing includes two magnetic bearing elements 3, 4 (or 8, 9, or 10, 11), which are disposed concentrically about one axis. *See* Baermann column 4, lines 28 to 36. It would be incorrect to interpret the two different magnets 3, 4 shown in Baermann as Applicant’s “annular permanent magnet (2, 3) divided in a circumferential direction thereof at at least one location (4) into a plurality of segments,” because the gap between the magnets 3, 4 is necessary for rotation of the magnets 3, 4 with respect to one another. Baermann also describes in column 6, lines 45-55 that these magnets 3, 4 have the same polarity in order to repel each other. Thus, these magnets 3, 4 cannot be interpreted as one “annular permanent magnet (2, 3) divided in a circumferential direction thereof at at least one location (4) into a plurality of segments,” as recited in claim 1.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal

Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as contained in the...claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). “The elements must be arranged as required by the claim...” In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Further, in the event that the Office Action is relying on the theory of inherency in any manner, “the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See also MPEP 2112. Because Baermann does not explicitly or inherently disclose every element as presently recited in independent claim 1, Baermann cannot be properly used to reject independent claim 1 under 35 U.S.C. § 102. Therefore, it is respectfully submitted that independent claim 1 is allowable over Baermann, and withdrawal of this rejection and allowance of this claim are earnestly solicited.

Regarding claims 2-6, it is respectfully submitted that for at least the reason that claims 2-6 depend from allowable independent claim 1, and therefore contain each of the features as recited in this claim, claims 2-6 are therefore also patentable over Baermann.

**Claim Rejection Under 35 USC 103**

Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Baermann in view of U.S. Patent No. 6,250,577 to Koenig. Applicant requests reconsideration of this rejection.

The Examiner acknowledges that Baermann does not disclose that the annular binding band is made from carbon-fiber material. The Examiner cites Koenig as allegedly teaching this feature. However, even if it is assumed that Koenig does teach this feature, Baermann and Koenig, either alone or in combination, fail to teach or suggest “at least one annular permanent magnet (2, 3) divided in a circumferential direction thereof at at least one location (4) into a plurality of segments, said segments spaced apart from one another at said at least one location,” as presently recited for the

reasons set forth above. Therefore, it is respectfully submitted that claim 7 is patentable over the references cited by the Examiner.

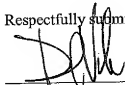
**Conclusion**

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

It is believed that no fee is due with this submission. If any further fees are required in connection with the filing of this amendment, please charge the same to out Deposit Account debit Account 50-0548.

Respectfully submitted,



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